

Remarks

Background: In their April 11, 2011 Response to Office Action and Amendment, Applicants submitted two additional expert reports. The expert reports are identified as follows:

- Technical Report V 10/17 “Production of Conditioned Filter Salts with Titanium Contents of 3-20% Relating to Iron for Examination in Cements” dated 26 August 2010, including Verification (Exhibit 5); and
- Technical Report F 7067/3 “Determination of the efficiency and resistance of ferrous sulfate as a chromate reducing agent – 3rd Interim Report” dated 2 March 2011, including a Verification. (Exhibit 6).

Applicants clearly indicated that the expert reports were being submitted “pursuant to 37 CFR § 1.132, in traverse of the pending rejection.” (pg. 3 Response to Office Action and Amendment, April 11, 2011)

The expert reports are verified. The precise language of the verification is reproduced below for the Office’s convenience.

I, Dr. Gerhard Auer, hereby declare that all statements made in the Crenox Technical Report V 10/17, dated August 26, 2010 of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issued thereon.

We, Dr. R. Rankers and Dipl.Ing. A. Vollpracht, hereby declare that all statements made in the Test Report F 7067/3 dated March 2, 2011, and entitled “Determination of the efficiency and resistance of ferrous sulfate as a chromate reducing agent” of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or

both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issued thereon.

Rejection: The Examiner stated the “the technical reports are not in Declaration form, thus not treated as a Declaration under 37 CFR 1.132.” (pg. 5, Office Action, September 13, 2011) Nevertheless, the Examiner considered the expert reports and commented on them in the Office Action.

Clarification: Applicants seek to confirm that the two expert reports, Applicant’s Exhibits 5 and 6, are entered into the case, in traverse of the previous rejection, pursuant to 37 CFR § 1.132.

In a telephone conference of Examiner Rebecca Lee, Applicants sought clarification, and an explanation of what the basis, if any, was for refusing admission of the expert reports.

- Ms. Lee refused to commit as to whether the reports had been admitted as evidence in the case.
- Ms. Lee indicated that Applicants should appeal and let the BPAI rule on the issue.
- Ms. Lee stated that there was no indication that the reports were submitted pursuant to 37 CFR § 1.132.
- The aforementioned language from the responses was brought to Ms. Lee’s attention.
- Next, Ms. Lee stated that the verification was not in the proper form.
- It was brought to Ms. Lee’s attention that the language used in the verification was taken from the USPTO’s own forms.

In sum, Ms. Lee refused to clarify the status of the evidence, despite each ground for objection having been shown to be specious. If there is a deficiency in the reports, Applicants can correct the deficiency, re-submit the reports, and place the application in condition for appeal. But, no valid objection has been raised.

Procedurally, it is inappropriate to submit an application to appeal, without knowing what is or is not admitted as evidence in the case. Applicants could be faced with a three-year delay, while the application languishes on appeal, only to be told that the case is being remanded to the examiner to clarify the status of the evidence.

Consequently, Applicants respectfully request that the Examiner confirm that Exhibit 5 and 6 have been admitted in the application

Sincerely,



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